

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Virinder BATRA, et al.	:	Confirmation Number: 6050
	:	
Application No.: 10/068,362	:	Group Art Unit: 2152
	:	
Filed: February 6, 2002	:	Examiner: A. Wildhalm
	:	
For:		OBTAINING LOCATION INFORMATION USING A REJECTION MODEL

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated August 31, 2007.

The Examiner's response to Appellant's arguments submitted in the Appeal Brief of June 1, 2007, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief of June 1, 2007, and the arguments set forth below.

1 Rejection under the 2nd paragraph of 35 U.S.C. § 112

2 On page 3-7 of the Appeal Brief, Appellants addressed the Examiner's (2) separate
3 rejections under the second paragraph of 35 U.S.C. § 112. The Examiner's response to these
4 arguments is found in the paragraph spanning pages 10 and 11 of the Examiner's Answer. Of
5 particular note, the Examiner asserted the following:

6 Appellant's arguments are focused on the interpretation of location-based processing in light of
7 pages 1-4 of appellant's disclosure. This section provides examples in which restrooms,
8 restaurants, and weather forecasts are provided based upon the actual geographic location of the
9 mobile user. Although these examples are helpful, they are still examples and do not provide an
10 explicit definition of location-based processing. Therefore, the scope of the claimed invention
11 includes processing based on geographic location, spatial location, and network location.
12 Examiner has rather rejected these claims under 35 USC 112 second paragraph to point out the
13 difference in scope between appellant's specification, arguments, and claims. Describing specific
14 system components would help define the scope, as well as including in the claims more detail as
15 to which interpretation of location-based processing is intended.

16
17 Although not explicitly stated in a straight-forward manner, upon reviewing this passage, it
18 appears that the Examiner is asserting that while Appellants are interpreting "location based
19 processing" in one manner (i.e., processing based on geographic location of the entity requesting
20 the processing/service), the Examiner believes the term "location based processing" has a
21 broader scope (i.e., also including processing based on spatial location and network location,
22 presumably of the processor). Because of this allegedly broader scope, the Examiner reasons
23 that "the scope of the claims is not commensurate with appellant's disclosure."

24
25 This analysis, by the Examiner, fails on several levels. As claimed, location-based
26 services are provided by location-based processing. The phrase "location based services" is not
27 as ambiguous as made out by the Examiner. A search¹ of issued U.S. patents for the exact
28 phrase "location based service"² yielded 140 hits.³ A quick review of the titles of these patents

¹ The search was performed at <http://patft.uspto.gov/netahtml/PTO/search-adv.htm>.

² As described in http://en.wikipedia.org/wiki/Location-based_service:

1 yields the conclusion that these patents deal with mobile units that receive information pertinent
2 to the location of the mobile unit based upon the location of the mobile unit.

3
4 For example, the earliest issued patent is U.S. Patent No. 5,740,538, with an issue date of
5 April 14, 1998. In the Background of the Invention section, it is stated:

6 Some organizations provide services or information to a user based on the location of the
7 user. For purposes of this specification, these organizations are referred to collectively as "location
8 based services" or "services." For example, one location based service provides current weather
9 information to users over the telephone network. To provide the user with the appropriate weather
10 information, the service must know the location of the user. Typically, such services use the caller-
11 ID service provided by the telephone network to determine the location of the user. For example,
12 the area code and exchange of a telephone number can provide the service with the location of a
13 wireline telephone. Based on this location information, a service can give the user accurate
14 information on, for example, the current weather, location of a restaurant or other location based
15 service.
16

17 This description of "location based services," made approximately 6 years prior to Appellants'
18 description of "location based services" in the present patent application, is consonant with
19 Appellants' description of the same.
20

21 On the contrary, despite the Examiner's alternative readings of the scope of "location
22 based services," the Examiner has failed to establish any objective evidence that supports the
23 Examiner's position that the phrase "location-based service" encompasses processing based on
24 spatial location and network location, presumably of the processor. Moreover, as noted in the
25 paragraph spanning pages 8 and 9 of the Appeal Brief, the Examiner's construction of "location-
26 based" completely reads any many out of the term. All services are performed at a location.⁴

Location-based services (LBS) (or LoCation Services, LCS) are services developed and distributed by wireless carriers and their partners which provide information specific to a location. The advantage is that mobile users don't have to manually specify ZIP codes or other location identifiers to use location-based services.

³ A similar searched performed on Google, i.e., using the exact phrase "location based service," yields 258,000 hits.

⁴ The "location" of any service being performed can be either broadly defined, such as a barber shop or a law office, or more narrowly defined, such as Suite 110B or a particular server with a particular address on a network.

Thus, based upon the Examiner's interpretation all services are "location based." However, in interpreting the phrase "location-based service" in this manner, the Examiner has impermissibly read the term "location-based" out of this phrase. In this regard, ignoring a claim term constitutes clear legal error.⁵

Rejection under 35 U.S.C. § 103 based upon Schwartz

On pages 7-12 of the Appeal Brief, Appellants presented several separate arguments as to why one having ordinary skill in the art would not have arrived at the claimed invention based upon Schwartz. Appellants first argument was that none of the passages within Schwartz cited by the Examiner describe location-based processing. The Examiner's response to this is found on page 11 of the Examiner's Answer. Of particular note, the Examiner asserted the following:

Although these examples are helpful, they are still examples and do not provide an explicit definition of location-based processing. Examiner was attempting to aid in furthering prosecution by pointing out other interpretations of location-based processing that falls within the scope of the claimed invention. A URL request falls within this scope, as do GML and GPS supported location-based processing. The URL request contains the address of a server and requests access to information located at that specific server. Because there is no definition in appellant's disclosure or the appealed claims, location-based processing is interpreted to mean the processing of information relating to a location, e.g. a network address. Schwartz follows this interpretation. (emphasis added)

These assertions have already been addressed above. Location-based processing/services have a very specific meaning to those skilled in the art. The Examiner's analysis as to "other interpretations of location-based processing," however, has no factual support. Although Appellants recognize that in construing claims the Examiner is to give a particular term its broadest, reasonable construction consistent with Appellants' specification, the Examiner's claim construction is not reasonable when the Examiner's interpretation is both factually unsupported

⁵ Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971); In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).

1 and inconsistent with the ordinary and customary meaning attributed to the phrase "location-
2 based services."

3
4 Under the second paragraph of 35 U.S.C. § 112, the claims are to "particularly [point]
5 and distinctly [claim] the subject matter which the applicant regards as the invention." However,
6 Appellants question how this requirement can be met when the Examiner's claim construction
7 reads the distinctiveness out of the claim terms used by Appellants.

8
9
10 On page 10 of the Appeal Brief, Appellants argued that a request for more information is
11 not a "rejection response," as claimed. The Examiner's presented a lengthy rebuttal on page 12
12 of the Examiner's Answer. Of note, the Examiner asserted:

13 Schwartz's response is a request for more information and is interpreted to be equivalent to a
14 rejection response because the original request lacked necessary information and could not be
15 completed as requested.
16

17 The error in the Examiner's analysis can be best described by analogy. When entering a website
18 that requires a ID/password, the website solely requesting the ID/password (e.g., after clicking
19 on a link to "Logon") does not constitute a "rejection response," given the ordinary and
20 customary meaning attached to that phrase. This is comparable to the disclosure of Schwartz.

21
22 However, if after submitting the ID/password, the response was "logon incorrect, please
23 e-mail address to have ID/password sent," such a occurrence would constitute a "rejection
24 response" and a request for more information. Upon reviewing the Examiner's cited passages
25 within Schwartz, Appellants are unable to find a comparable teaching to the claimed rejection
26 response.

1
2 The Examiner further asserted the following with regard to Appellants argument that the
3 Schwartz fails to teach request for "required location information." The Examiner responded as
4 follows:

5 And regarding appellant's argument that the request for more information taught by Schwartz is
6 not a request for the location of the pervasive computing device, examiner responds that the claim
7 states "a request for required location information." There is no explicit definition in appellant's
8 disclosure or within the claims that "required location information" is the location of the pervasive
9 computing device. The pervasive device sends the network requests for location-based processing,
10 however there is also nothing in the claim linking the location of the pervasive device with the
11 required location information.
12

13 The Examiner's response is notable, not for what is asserted, but for what is not asserted.
14 Specifically, although the Examiner asserts that there is no required definition for "required
15 location information," the Examiner omits, from this passage, an explanation as to why the
16 Examiner's interpretation of the phrase "required location information" is reasonable in light of
17 Appellants' specification.
18

19
20 On pages 10-12 of the Appeal Brief, Appellants presented arguments as to the Examiner's
21 failure to teach the claimed "locating said required location information from within said stored
22 network request. The Examiner's response to this rejection is found in the paragraph spanning
23 pages 12 and 13 of the Examiner's Answer and reproduced, in part, below:

24 As to appellant's argument that Schwartz did not disclose fulfilling requests for additional
25 information with stored information and that one of ordinary skill in the art would not have been
26 motivated to do so based on Schwartz' teachings (appeal brief p. 10-12), examiner respectfully
27 disagrees. Schwartz described sending a request and in response to this request, receiving a request
28 for more information. The user then provides the additional information and the previous request
29 is updated, i.e. a new request is generated. This new request is then passed to a link server and
30 then either filled from information stored in the link server or the request is passed again to a
31 network server.
32

1 At the outset, Appellants note that the Examiner's assertion that "examiner respectfully
2 disagrees" misstates the Examiner's position. Referring to page 7 of the Third Office Action and
3 pages 5 and 6 of the Examiner's Answer, the Examiner has revised the Examiner's previously-
4 stated position. Specifically, the Examiner is now only asserting that Schwartz teaches "locating
5 said required location information," whereas previously, the Examiner argued that Schwartz
6 teaches "locating said required location information from with said stored network request."

7
8 The Examiner further argued in the same paragraph the following

9 Examiner provided a 35 USC 103(a) rejection because Schwartz did not explicitly disclose
10 providing the requested additional information from a stored request. Schwartz disclosed fulfilling
11 other requests with stored information instead of forwarding those requests to another server.
12 Filling requests locally when possible reduces needless network traffic and conserves network
13 bandwidth. Therefore the capability to fulfill requests with stored information and the motivation
14 to do so was described. It would have been obvious to one of ordinary skill in the art at the time of
15 invention to fulfill requests for additional information with stored information and thereby reduce
16 needless network traffic.

17
18 Notwithstanding the Examiner's assertion that the "capability to fulfill requests with stored
19 information" is obvious, the Examiner has failed to explain the common sense rationale for
20 fulfilling the request for location information from information in the stored *network request*.
21 Based upon the Examiner's own analysis, the "location information" being supplied is from the
22 user (see column 17, lines 36-37), which is not in the form of a network request.

23
24 Thus, the Examiner has not established that this location information being retrieved is
25 found in a network request. Thus, although it may be obvious retrieve location information from
26 stored information, the Examiner has not established that it is obvious to retrieve location
27 information stored in a network request. Moreover, for the Examiner to establish that the
28 location information is available to be retrieved from the network request, the Examiner also has

1 to establish that the network request is stored at the time the rejection response is received. This
2 factual finding, however, has not been made by the Examiner.

3
4 Appellants also note that the Examiner's asserted rationale is not supported by a logical
5 analysis. As asserted by the Examiner, Schwartz obtains the alleged "location information"
6 directly from the user. This alleged "location information" is required after the user drills down
7 from the entry portal (i.e., Fig. 7A) through various pages (i.e., Figs. 7B-7F) until the user arrives
8 at Fig. 7G, which requests that the user enter the name of the town upon which news is
9 requested. If Schwartz were to be modified, as suggested by the Examiner, so that the initial
10 request contains the additional information needed for the location-based processing, the initial
11 request would not only have to include the alleged "location information" (i.e., the name of the
12 town), but also all the other possible information needed to respond to a request. Based upon all
13 the possible permutations of information that could be entered in the various pages (i.e., Figs.
14 7B-7F), there could be hundreds, if not thousands of possible "information" that needs to be
15 included in the initial request in order to meet the Examiner's asserted benefit of "[reducing]
16 needless network traffic." To include all this information would be cumbersome, network
17 intensive, and require the user to make predictions, at the very beginning, as to what alleged
18 "location-based processing" the user wants to perform. Thus, the Examiner's obviousness
19 analysis fails to recognize the excessive burdens (which far outweigh the alleged benefit) placed
20 on both the user, software designer, and network if the Examiner's proposed modifications were
21 to be implemented.

Rejection under 35 U.S.C. § 103 based upon Kimoto in view of Liming

On pages 12-15 of the Appeal Brief, Appellants presented, among others, arguments as to why Kimoto fails to teach "receiving a rejection response to said forwarded network request and identifying in said rejection response a request for required location information." The Examiner's response to these arguments is found in the paragraph spanning pages 13 and 14 of the Examiner's Answer and reproduced below:

Examiner did not cite step D1 of figure 46 to teach a request for location-based processing. Figure 46 is a registration process in which additional location information is requested of the user. When starting the registration process, a request to begin the registration process is inherently included. A user sends position information and during the registration process, additional information is requested. (emphasis added)

The Examiner's above-underlined inherency argument is newly presented, and Appellants submit that the Examiner's reliance upon the doctrine of inherency to disclose this feature is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.⁶ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁷ Furthermore, reference is made to ex parte Schricker,⁸ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

⁶ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁷ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

⁸ 56 USPQ2d 1723, 1725 (BPAI 2000).

1
2 The Examiner did not discharge that burden of indicating where such a teaching appears in the
3 prior art. Thus, the Examiner has not established that this limitation is inherently disclosed by
4 Kimoto. Appellants also note that the Examiner has not addressed many of Appellants other
5 arguments regarding the proposed combination of Kimoto and Liming.

6
7
For the reasons set forth in the Appeal Brief of June 1, 2007, and for those set forth
herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections
under 35 U.S.C. §§ 103, 112.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is
hereby made. Please charge any shortage in fees due in connection with the filing of this paper,
including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to
such deposit account.

Date: October 31, 2007

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320